AF/2175

Atty. Docket No. COM31 P-301 (PER19 P-301)

DFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Art Unit	:	2175
Examiner	:	Thuy N. Pardo
Applicant	:	Therese A. Voevodsky
Appln. No.	:	09/602,921
Filed	:	June 23, 2000
Confirmation No.	:	1017
For	:	HUMAN RESOURCES INFORMATION INTERNET ACCESSIBLE DATABASE

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

TRANSMITTAL OF APPEAL BRIEF
(PATENT APPLICATION - 37 CFR §1.192)

1. Transmitted herewith, in triplicate, is the APPELLANT'S BRIEF in this application, with respect to the Notice of Appeal filed on May 25, 2004.

2. **STATUS OF APPLICANT**

This application is on behalf of:

____ other than a small entity.

_x_ a small entity.

A verified statement:

____ is attached.

_x_ was already filed.

3.   **FEE FOR FILING APPEAL BRIEF**

Pursuant to 37 CFR §1.17(c), the fee for filing the Appeal Brief is:

 x small entity $165.00

___ other than a small entity $320.00

           Appeal Brief fee due: $165.00

4.   **EXTENSION OF TERM**

The proceedings herein are for a patent application and the provisions of 37 CFR §1.136 apply.

(complete (a) or (b), as applicable)

(a)   ___   Applicant petitions for an extension of time under 37 CFR §1.136:

Extension (months)	Fee for other than small entity	Fee for small entity
___ one month	$110.00	$55.00
___ two months	$420.00	$210.00
___ three months	$950.00	$475.00
___ four months	$1,480.00	$740.00

                                                    FEE: $ 0.00

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

(b)   x   Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that Applicant has inadvertently overlooked the need for a petition and fee for extension of time.

5.   **TOTAL FEE DUE**

The total fee due is:

Appeal Brief fee: $165.00

Extension fee (if any) $ 0.00

           TOTAL FEE DUE: $165.00

6. FEE PAYMENT

  x   Attached is a check in the sum of $165.00.

  __   Charge Account No. 16-2463 the sum of $_____.

A duplicate of this transmittal is attached.

7. FEE DEFICIENCY

  x   If any additional extension and/or fee is required, this is a request therefor

and to charge Account No. 16-2463.

and/or

  x   If any additional fee for claims is required, charge Account No. 16-2463.

Respectfully submitted,

THERESE A. VOEVODSKY

By: PRICE, HENEVELD, COOPER,
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07-21-04
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APPELLANT'S BRIEF (37 CFR §1.192)

This brief is in furtherance of the Notice of Appeal, filed in this case on May 25, 2004.

The fees required under §1.17(c), and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief is filed in triplicate. (37 CFR §1.192(a)).

This brief contains these items under the following headings, and in the order set forth below (37 CFR §1.192(c)):

I.   Real Party in Interest

II.   Related Appeals and Interferences

III.   Status of Claims

IV.   Status of Amendments

V.   Summary of Invention

VI.   Issues

VII.   Grouping of Claims

VIII.   Argument

      A.   U.S. Patent No. 6,401,079 issued to Kahn et al.

      B.   U.S. Patent No. 5,737,592 issued to Nguyen et al.

      C.   Legal Considerations

IX.   Conclusion

Appendix of Claims (double spaced) Involved in the Appeal

The final page of this brief bears the attorney's signature.

I.   Real Party in Interest

The real party in interest in this application is Therese A. Voevodsky.

II.   Related Appeals and Interferences

Appellant is aware of no appeals or interferences that would directly affect or be directly affected by, or have a bearing on, the Board's decision in the pending appeal.

III.   Status of Claims

This is an appeal from a Final Rejection of claims 1-21 of the above-identified application. Appealed claims 1-21 are attached in the Appendix hereto.

IV.   Status of Amendments

The Amendment to the claims filed May 12, 2003, has been entered in this application.

V.   Summary of the Invention

The present invention is directed to a method (200: Fig. 2) and system (124: Fig. 1) that facilitates automated comparison of employee data, such as employee compensation data (e.g., salaries, bonuses, benefits), between a plurality of subscribers. Accessing a computer system, programmed according to the present invention, allows progressive companies to respond to compensation increases in a job marketplace, thus, allowing a company to retain key personnel

and allowing the company to fill key positions (p. 7, lines. 2-5). A subscriber can transfer/receive information to/from a database 120 that stores employee compensation data, by accessing web server 118. The present invention is particularly useful in determining whether employees with a desired employee attribute (defined as skills and responsibilities at page 4, lines 22-23) are adequately compensated, as compared to employees in other non-related companies. For example, if a subscriber was interested in employee compensation data for a computer programmer, the subscriber might enter, "programmer, C, Visual Basic" in the "skills and responsibilities" category of the query form (p. 9, lines 21-23 and Fig. 4). Table 1 (page 6) sets forth exemplary subscriber data in an exemplary record format that includes a "skills and responsibility" category for receiving one or more employee attributes, as well as a "job title" category, a "job code" category, etc.

With reference to Fig. 2, an exemplary employee compensation routine (200) is depicted. The routine 200 allows a subscriber the option of choosing to create a new report (214), at which point skill requirements for an individual are entered (216). Next, scope measures for the survey are entered (218). A scope measure may be based on whether a company is a profit/non-profit company, in a particular industry, within a certain range of sizes, has a company revenue in a certain range and/or geographic location, among other factors (see page 11, lines 20-23). Then, relevant information is retrieved (220), the retrieved information is formatted (222) and a report is provided to the subscriber (224). Alternatively, a subscriber may choose to update an existing report (214). Upon selecting the report to be updated, relevant information is retrieved (220), the retrieved information is formatted (222) and a report is provided to the subscriber (224).

VI. Issues

The issues are:

A. The first issue on appeal is whether claims 1, 3-8, 10-15 and 17-21 are patentable under 35 U.S.C. §102(e) over U.S. Patent No. 6,401,079 issued to Kahn et al.

B.   The second issue on appeal is whether claims 2, 9 and 16 are patentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,401,079 issued to Kahn et al. in view of U.S. Patent No. 5,737,592 issued to Nguyen et al.

VII. Grouping of Claims

For purposes of this appeal, the claims are broken down into the following groups:

1.   Claims 1, 3-8, 10-15 and 17-21 stand or fall together; and

2.   Claims 2, 9 and 16 stand or fall together.

VIII. Arguments

In the arguments below, brief descriptions are provided for each of the applied references, followed by Appellant's arguments as to why claims 1, 3-8, 10-15 and 17-21 are not anticipated under 35 U.S.C. §102(e) by U.S. Patent No. 6,401,079 issued to Kahn et al. and why a *prima facie* case of obviousness under 35 U.S.C. §103(a) of claims 2, 9 and 16 has not been established based upon U.S. Patent No. 6,401,079 issued to Kahn et al. in view of U.S. Patent No. 5,737,592 issued to Nguyen et al.

A.   U.S. Patent No. 6,401,079 issued to Kahn et al.

U.S. Patent No. 6,401,079 issued to Kahn et al. (hereinafter Kahn) is directed to a system for Web-based payroll and benefits administration. The Kahn system purports to provide an automated, centralized back-end payroll service, with a full-featured web-based payroll system. The Kahn system implements and enforces compliance with a wide variety of tax-related and employment-related rules across federal, state and local jurisdictions relating to overtime pay, benefit limits, payment frequency and scheduled reporting requirements. The Kahn system also calculates employee income taxes, pre-tax deductions and post-tax deductions, overtime, imputed income, paid-time-off benefits and allocates payment sharing between employers and employees.

B.   U.S. Patent No. 5,737,592 issued to Nguyen et al.

U.S. Patent No. 5,737,592 to Nguyen et al. (hereinafter Nguyen) is directed to a method and apparatus for executing structured query language (SQL) queries in a relational database management system (RDBMS), via the World Wide Web.   Hyper-text mark-up language (HTML) input forms are utilized by a Web browser user to request information from the RDBMS, which receives the request as an SQL query.   The results of the SQL query are then transformed into an HTML format for presentation to the Web browser user.

C.   Legal Considerations

1. REJECTION OF GROUP I CLAIMS UNDER 35 U.S.C. §102(e)

Section 2143 of the latest revision of the *Manual of Patent Examining Procedures* (MPEP) states the following regarding the requirements for establishing anticipation of a claim:

> A claim is anticipated only if each and every element as set forth in
> the claim is found, either expressly or inherently described, in a
> single prior art reference. *Verdegaal Bros. v. Union Oil Co. of
> California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.
> 1987)

At the outset, Appellant notes that Kahn is generally directed to a computerized system that ensures compliance with a wide variety of tax-related and employee-related rules across federal, state and local jurisdictions, relating to, for example, overtime pay, benefits limits, payment frequency and scheduled reporting requirements.   Appellant additionally notes that Kahn is directed to a processing tool that is primarily used by a single employer to process the single employer's payroll.   Contrary to the Examiner's assertion, neither the Abstract, column 5, lines 40-46 nor column 11, lines 34-42 of Kahn teach a Web-based system that shares information between multiple employers.   In fact, at column 20, lines 30-33, Kahn states "[t]he system's security functionality only permits access to information about a particular Employer to that Employer or to authorized customer support personnel."

Further, while Kahn discloses storing certain employee data, Kahn does <u>not</u> teach correlating employee data to a plurality of employee attributes, as is defined by Appellant's claims, as amended on May 12, 2003, to include <u>at least one of an employee skill and an employee responsibility</u>. In fact, at column 22, lines 7-12, Kahn states "'Job Classifications' table 270 includes information regarding industry-standard job classifications, including classification name and ID(s) of Employer(s) using a particular job classification. This information can be used to create pay scales based on tenure of an Employer's employees across different job classifications." Appellant acknowledges that Kahn, column 22, lines 12-14 states "[t]his information can be used to create salary surveys across different Employers using industry-standard job classifications." However, Appellant notes that Kahn is limited to creating salary surveys using "industry-standard job classification," i.e., correlating employee compensation data with "industry-standard job classifications," which does not teach or suggest correlating employee data with a plurality of employee attributes that includes "at least one of an employee skill and an employee responsibility," as is set forth in Appellant's independent claims 1, 8 and 15.

Appellant also acknowledges that Kahn, column 37, line 58 through column 38, line 14, states "[t]he 'Job Classifications' interface, illustrated by Fig. 22, is selectable from sub-menu 3920 and enables input and modification of Employer-defined pay scales for particular job classifications. The job classifications may be standard industry classifications or Employer-defined classifications. In an embodiment of this invention, pay scales for particular job classifications across an industry can be aggregated from multiple Employers that use the system, in order to create comparative survey data that shows typical salaries for particular jobs. As shown in Fig. 22, the system displays standard industries in 'Industries' pull-down menu 3925. When the user selects a particular industry, for example 'Engineering Services,' the system displays the standard job classifications within that industry in a selectable list in 'Job Classifications' field 3930. The system also displays daily custom job classifications defined by the particular Employer within that industry. Selecting a particular job classification, for

example 'Junior Engineer' (denoted by the arrow adjacent to the classification), causes the system to display the Employer-defined pay scale for that classification, including effective date, expiration data, and pay rate scheduled across periods of service (e.g., 0-12 mos. = $110/hour; 13-1200 mos. = $220/hour)." However, Appellant submits that this statement appears to contradict the statement at column 20, lines 30-33 regarding system security. Further, Appellant notes that any comparative salary survey would only be based on "industry-standard job classifications" and not on a plurality of employee attributes that includes at least one of an employee skill and an employee responsibility, as set forth in Appellant's independent claims 1, 8 and 15. In addition, Appellant submits that claims 3-7, 10-14 and 17-21 are dependent upon allowable claims and, as such, are also allowable.

For at least the reasons discussed above, Appellant submits that claims 1, 3-8, 10-15 and 17-21 are allowable over the teachings of Kahn, and, thus, the rejection of the claims under 35 U.S.C. §102(e) should be overturned.

2. REJECTION OF GROUP II CLAIMS UNDER 35 U.S.C. §103(a)

Appellant respectfully submits that the Examiner has failed to establish *prima facie* obviousness of the claimed invention recited in claims 2, 9 and 16 over the teachings of Kahn as combined with Nguyen. Section 2143 of the latest revision of the *Manual of Patent Examining Procedures* (MPEP) states the following regarding the requirements for establishing a *prima facie* case of obviousness:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. [emphasis added]

Appellant submits that the cited combination does not teach or suggest all the claimed features of the invention and, for this reason, Appellant submits that the Examiner has failed to establish a *prima facie* case of obviousness. More specifically, the combination of the Kahn and Nguyen, as applied to claims 2, 9 and 16, does not teach or suggest a method and/or system that compiles a report from a database that includes employee data correlated to a plurality of employee attributes, which includes <u>at least one of an employee skill and an employee responsibility</u>, after receiving a query from a subscriber that includes at least one desired employee attribute. As noted above, at the most Kahn discloses comparative salary surveys using "industry-standard job classifications."

For at least the reasons discussed above, Appellant submits that claims 2, 9 and 16 are allowable over the teachings of Kahn as combined with Nguyen, and, thus, the rejection of the claims under 35 U.S.C. §103(a) should be overturned.

IX.   Conclusion

For the reasons set forth above, and as apparent from examining the invention defined by claims 1-21, when properly considering the cited references, these claims define patentable subject matter. Accordingly, reversal of the rejections of the claims under §102(e) and §103(a) is appropriate and is respectfully solicited.

Respectfully submitted,

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By: PRICE, HENEVELD, COOPER,
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_07-21-04_
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Appendix of Claims (37 CFR §1.192(c)(9))

1. (Amended) A method that facilitates automated comparison of employee data between a plurality of subscribers, comprising the steps of:

maintaining a database of subscriber data that is provided by a plurality of subscribers, the subscriber data including employee data for a plurality of employees, wherein the employee data is correlated to a plurality of employee attributes, and wherein the plurality of employee attributes includes at least one of an employee skill and an employee responsibility and the plurality of subscribers includes at least two subscribers from non-related companies;

receiving a query from a specific subscriber, the query including at least one desired employee attribute; and

compiling a report from the database in response to the query, the report providing associated employee data for employees that have the at least one desired employee attribute.

2. The method of claim 1, wherein the report is electronically provided to the specific subscriber via an HTML form.

3. The method of claim 1, further including the steps of:

associating the query with the specific subscriber;

storing the query; and

providing an updated report when the specific subscriber selects the stored query, wherein the specific subscriber is not required to again enter the at least one desired employee attribute associated with the stored query.

4.   The method of claim 1, wherein the employee data is employee compensation data and the report provides a comparison between the employee compensation data of the specific subscriber and the employee compensation data of all other subscribers with the at least one desired employee attribute.

5.   The method of claim 1, wherein the query includes at least one scope measure.

6.   The method of claim 1, wherein the report includes a summary of the at least one desired employee attribute used to compile the report.

7.   The method of claim 1, wherein the report includes the employee data in tabular and graphical format.

8.   (Amended)   A computer system that facilitates automated comparison of employee data between a plurality of subscribers, comprising:

a processor;

a memory subsystem for storing data and information coupled to the processor; and

processor executable code located within the memory subsystem for causing the processor to perform the steps of:

maintaining a database of subscriber data that is provided by a plurality of subscribers, the subscriber data including employee data for a plurality of employees, wherein the employee data is correlated to a plurality of employee attributes, and wherein the plurality of employee attributes includes at least one of an employee skill and an employee responsibility and the plurality of subscribers includes at least two subscribers from non-related companies;

receiving a query from a specific subscriber, the query including at least one desired employee attribute; and

compiling a report from the database in response to the query, the report providing associated employee data for employees that have the at least one desired employee attribute.

9.   The system of claim 8, wherein the report is electronically provided to the specific subscriber via an HTML form.

10.   The system of claim 8, further including the steps of:

associating the query with the specific subscriber;

storing the query; and

providing an updated report when the specific subscriber selects the stored query, wherein the specific subscriber is not required to again enter the at least one desired employee attribute associated with the stored query.

11.   The system of claim 8, wherein the employee data is employee compensation data and the report provides a comparison between the employee compensation data of the specific subscriber and the employee compensation data of all other subscribers with the at least one desired employee attribute.

12.   The system of claim 8, wherein the query includes at least one scope measure.

13.   The system of claim 8, wherein the report includes a summary of the at least one desired employee attribute used to compile the report.

14.   The system of claim 8, wherein the report includes the employee data in tabular and graphical format.

15. (Amended) A human resource information system that facilitates automated comparison of employee compensation data between a plurality of subscribers, comprising:

a processor;

a memory subsystem for storing data and information coupled to the processor; and

processor executable code located within the memory subsystem for causing the processor to perform the steps of:

maintaining a database of subscriber data that is provided by a plurality of subscribers, the subscriber data including employee compensation data for a plurality of employees, wherein the employee compensation data is correlated to a plurality of employee attributes, and wherein the plurality of employee attributes includes at least one of an employee skill and an employee responsibility and the plurality of subscribers includes at least two subscribers from non-related companies;

receiving a query from a specific subscriber, the query including at least one desired employee attribute and at least one scope measure; and

compiling a report from the database in response to the query, the report providing associated employee compensation data for employees that have the at least one desired employee attribute.

16.   The system of claim 15, wherein the report is electronically provided to the specific subscriber via an HTML form.

17.   The system of claim 15, further including the steps of:

associating the query with the specific subscriber;

storing the query; and

providing an updated report when the specific subscriber selects the stored query, wherein the specific subscriber is not required to again enter the at least one desired employee attribute associated with the query.

18.   The system of claim 15, wherein the report provides a comparison between the employee compensation data of the specific subscriber and the employee compensation data of all other subscribers with the at least one desired employee attribute.

19.   The system of claim 15, wherein the at least one scope measure includes at least one of the following categories: profit, nonprofit, industry, company size, company revenue and geographic location.

20.   The system of claim 15, wherein the report includes a summary of the at least one desired employee attribute used to compile the report.

21.   The system of claim 15, wherein the report includes the employee compensation data in tabular and graphical format.